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10 Number of Pages (including this page)

Date:	9/04/03
To:	Commissioner for Patents
Location:	United States Patent and Trademark Office
Fax No.:	703-872-9314
From:	Matthew C. Loppnow Registration No. 45,314
Subject:	**Serial No. 09/611,633** Docket No. PF01960NA

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MESSAGE:

Enclosed herewith, please find:

- ☒ Amendment
- ☒ Amendment Transmittal Form
- ☒ Fee Transmittal Form
- ☐ Petition for Extension of Time

PLEASE GIVE THESE PAPERS TO:

EXAMINER:	**Yang, C.**
GROUP ART UNIT:	2635
SERIAL NO.:	09/611,633
FILED:	July 7, 2000
INVENTOR:	Goldberg, Steven J.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ADMENDMENT TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/611,633
Filing Date	July 7, 2000
First Named Inventor	Goldberg, Steven J.
Group Art Unit	2635
Examiner Name	Yang, C.
Attorney Docket Number	PF01960NA

ENCLOSURES *(Check all that apply)*

- ☒ Fee Transmittal Form
  - ☐ Fee Attached
- ☒ Amendment/Response
  - ☒ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Assignment Papers *(for an Application)*
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition Routing Slip (PTO/SB/69) and Accompanying Petition
- ☐ Change of Correspondence Address
- ☐ Fee Address Indication Form
- ☐ Terminal Disclaimer
- ☐ Small Entity Statement
- ☐ Request for Refund
- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to Group *(Appeal Notice, Brief, Reply Brief)*
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Additional Enclosure(s) *(please identify below)*

Remarks:

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☐ Customer Number or Bar Code Label 20280 (Insert Customer No. or Attach bar code label here) or ☐ Correspondence address below

Name:	Motorola, Inc.		
Address:	Intellectual Property Department		
	600 North U.S. Highway 45, AN475		
City: Libertyville	State: Illinois	Zip Code:	60048
Country: USA	Telephone: 847-523-2585	Fax:	847-523-2350
Name (Print/Type) Matthew C. Loppnow		Registration No.	45,314
Signature	Date 9/4/03		

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent Office at 703-872-9314 on this date: 9/04/03

Typed or printed name: Jennifer Magness

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

FEE TRANSMITTAL For FY 2003

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT	($) 0.00

Application Number	09/611,633
Filing Date	July 7, 2000
First Named Inventor	Goldberg, Steven J.
Group Art Unit	2635
Examiner Name	Yang, C.
Attorney Docket Number	PF01960NA

METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account: 50-2117
Deposit Account Name: Motorola, Inc.

☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

☐ Applicant claims small entity status See 37 CFR 1.27

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Fee ($)	Fee Description	Fee Paid
101	750	Utility filing fee	
106	330	Design filing fee	
107	520	Plant filing fee	
108	750	Reissue filing fee	
114	160	Provisional filing fee	
		SUBTOTAL (1)	($) 0.00

2. EXTRA CLAIM FEES

	Extra Claims		Fee Paid
Total Claims	21 - 21 =	0 X 18 =	0
Independent Claims	3 - 3 =	0 X 84 =	0

Multiple Dependent 89

Large Fee Code	Entity Fee ($)	Fee Description
103	18	Claims in excess of 20
102	84	Independent claims in excess of 3
104	280	Multiple dependent claim, if not paid
109	84	** Reissue independent claims over original patent
110	18	** Reissue claims in excess of 20 and over original patent
		SUBTOTAL (2) ($) 0.00

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Fee Code	Entity Fee ($)	Fee Description	Fee Paid
105	130	Surcharge - late filing fee or oath	
127	50	Surcharge - late provisional filing fee or cover sheet	
139	130	Non-English specification	
147	2,520	For filing a request for ex parte reexamination	
112	920*	Requesting publication of SIR prior to Examination action	
113	1,840*	Requesting publication of SIR after Examination action	
115	110	Extension for reply within first month	
116	410	Extension for reply within second month	
117	930	Extension for reply within third month	
118	1,450	Extension for reply within fourth month	
128	1,970	Extension for reply within fifth month	
119	320	Notice of Appeal	
120	320	Filing a brief in support of an appeal	
121	280	Request for oral hearing	
138	1,510	Petition to institute a public use proceeding	
140	110	Petition to revive - unavoidable	
141	1,300	Petition to revive - unintentional	
142	1,300	Utility issue fee (or reissue)	
143	470	Design issue fee	
144	630	Plant issue fee	
122	130	Petitions to the Commissioner	
123	50	Petitions related to provisional applications	
126	180	Submission of Information Disclosure Stmt	
581	40	Recording each patent assignment per property (times number of properties)	
146	750	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	750	For each additional invention to be examined (37 CFR § 1.129(b))	
179	750	Request for Continued Examination (RCE)	
169	900	Request for expedited examination of a design application	

*Reduced by Basic Filing Fee Paid SUBTOTAL (3) ($) 0.00

SUBMITTED BY

Name (Print/Type)	Matthew C. Loppnow	Reg. No. (Atty/Agent)	45,314
Signature		Date	9/04/03

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	GOLDBERG, Steven J.	EXAMINER:	Yang, C.
SERIAL NO.:	09/611,633	GROUP:	2635
FILED:	July 7, 2000	CASE NO.:	PF01960NA

ENTITLED: METHOD AND APPARATUS FOR TRANSMITTING AND DECODING PRE-PROGRAMMED MESSAGES

Motorola, Inc.
Intellectual Property Department
600 North U.S. Highway 45
Libertyville, IL 60048

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

In response to the Office Action dated June 24, 2003, reconsideration in view of the following remarks is respectfully requested.

Claims 1-21 are pending in this application.

The Office Action maintains the rejection of claim 1 under the judicially created doctrine of obviousness type double patenting over claim 1 of Goldberg (U.S. Patent No. 5,530,437) and Tani et al. (U.S. Patent No. 4,559,526). The Office Action also maintains the rejection of claims 2, 10, 16, and 19-21 under the judicially created doctrine of obviousness type double patenting over claims 1, 8, 9, and 12-14 of Goldberg. These rejections are respectfully traversed.

The Office Action additionally maintains the rejection, under 35 U.S.C. § 103, of claims 1-4, 10-12, and 15 over Goldberg and Tani et al., claims 1, 5, and 7 over Goldberg and Fish

(U.S. Patent No. 5,166,664), claims 6, 8, and 9 over Goldberg, Fish, and Reis et al. (U.S. Patent No. 5,973,613), claims 11 and 13 over Goldberg and Lemelson (U.S. Patent No. 6,054,928), and claim 14 over Goldberg, Tani et al., and Fish. These rejections are respectfully traversed.

Applicant maintains these rejections are deficient because the Office Action not met the burden of establishing a prima facie case of obviousness. In particular, there is no motivation to combine the reference teachings. Because there is no motivation, the double patenting rejections and the rejections under 35 U.S.C. §103 are deficient.

More particularly, no reference or combination of references disclose an deficiency in Fish, Lemelson, or Tani et al. that would necessitate one of ordinary skill in the art to look to Goldberg or vice versa. The deficiencies are also not provided by knowledge of one of ordinary skill in the art.

The Office Action attempts to piecemeal combine elements of the references with Goldberg by alleging the other references arguably utilize methods on how to avoid collisions and therefore are analogous. In particular, the Office Action attempts to pick and choose elements from each reference to satisfy the elements of the claims while ignoring the purpose of each element in the references and without providing proper motivation to combine the references.

As asserted in the previous Amendment, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

The present Office Action appears to concede the deficiency of the original motivation alleged in the first Office Action because the original motivation is no longer asserted.

Furthermore, in paragraph 2.a., the Office Action admits that Goldberg teaches using programmed orthogonal bit patterns used for identifying each portable communication unit (PCU) instead of triggering events. The Office Action then alleges "it is understood that Tani's emergency data are a type of canned messages." However, the Office Action has not provided any motivation to use the emergency data disclosed in Tani et al. to replace the bit patterns disclosed in Goldberg. In fact, such a replacement would subvert the operation of Goldberg. The bit patterns disclosed in Goldberg are necessary to identify the portable communication unit. Replacing the bit patterns with emergency data would prevent proper identification of the portable communication unit and would thus render Goldberg unsatisfactory for its intended purpose (see MPEP §2143.01). Thus, not only is there no motivation to replace the bit patterns with trigger events, such replacement would subvert the operation of Goldberg.

In section 2.d., the Office Action alleges "Tani teaches an improvement to a wireless communication system wherein each transmitter/receiver 2 is able to response [sic] to polling signals and is also able to detect a trigger." This statement does not amount to motivation to combine the references because it is untrue. Moreover, this statement does not amount to motivation to combine the references because it is inconceivable to modify the system taught in Goldberg with the system taught in Tani.

First, this statement does not amount to motivation to combine the references because it is untrue. Tani does not teach an improvement to a wireless communication system. Tani expressly teaches an improvement to a security alarm system (Title, Abstract, and col. 1, lines 6-13), not an improvement to a wireless communication system. Tani goes on to state the express objects of the invention are to provide a security alarm system and a security system using radio transmission (col. 1, lines 44-54). These are improvements to security systems, not wireless communication systems. Furthermore, Tani never expressly or implicitly makes any statement regarding improving a wireless communication system. Accordingly, the apparent motivation alleged by the Office Action is untrue.

Second, this statement does not amount to motivation to combine the references because it is inconceivable to modify the system taught in Goldberg with the system taught in Tani. In particular, Goldberg teaches a system including portable communication units. There is no

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reason why it would be useful to include fire sensors and intrusion detectors (Tani, col. 2, lines 42-45) on the portable communication units of Goldberg to detect a triggering event. Not only is there no reason present in the references, but also such a reason is not asserted by the Office Action. Accordingly, there is no motivation to combine the references because it is inconceivable to modify the system taught in Goldberg with the system taught in Tani.

In paragraph 2.e., the Office Action asserts "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning... as long as it... does include knowledge gleaned only from the applicant's disclosure." However, the Office Action does use knowledge gleaned from Applicant's disclosure. In particular, the Office Action attempts to piecemeal find each element of the claims in different references. The Office Action then attempts to fabricate motivation to support a combination of the elements. Unfortunately, this motivation is not present in the references and is not present in the knowledge available to one of ordinary skill in the art. The alleged motivation is only an attempt to rationalize the combination of elements to maintain the rejection.

The Office Action further alleges that Tani et al. is in an analogous art to Goldberg because Tani et al. "teaches a method of generating a response to a poll." Applicants disagree. Applicant maintains neither Tani et al. nor Goldberg is in the field of Applicant's or each other's endeavor and neither reference is reasonably pertinent to a particular problem with which the inventor is concerned (MPEP §2145 IX). As discussed above, Tani et al. expressly deals with improvements to security systems. To the contrary, Goldberg expressly deals with problems with simulcast responses from portable communication units. Goldberg does not address security systems. Similarly, Tani et al. does not address simulcast responses from portable communication units. Thus, neither reference is in the field of Applicant's or each other's endeavor and neither reference is reasonably pertinent to a particular problem with which the inventor is concerned.

In paragraph 2.f., the Office Action alleges "it would have been obvious to modifying [sic] Goldberg's method such that the specific times are randomly selected in order to prevent the simultaneous response from each subset of the PUCs 18 from colliding." Applicants disagree. If such modification prevented the simultaneous response as asserted by the Office

Action, then there would be no need to utilize the interference bit pattern of Goldberg to solve the difficulties with simultaneous responses. Thus, it would not be obvious to modify Goldberg's method to randomly select specific times in order to prevent the simultaneous response from each subset of PUCs 18 from colliding.

In paragraph 2.g. the Office Action alleges "because Lemelson imparts that standard cellular telephone technology can be used for radio control links 46 (see Col. 9, lines 65 - 67), it is understood that time division multiple access (TDMA) is used and that time slots are assigned for each processor unit." This is untrue. Lemelson does teach radio control links "may make use of radio communications, standard cellular telephone technology or other two-way radio communication methods." However, this does not amount to expressly using time division multiple access. In particular, this amounts to the ability to use numerous types of communications including radio communications, code division multiple access cellular telephone technology, analog cellular telephone technology, or other two-way radio communication methods. Because of the numerous types of communications available, there is absolutely no reason to insinuate Lemelson would utilize a system that requires correction from the teachings of Goldberg. Thus, it is not true that it is "understood" that time division multiple access is used in the system of Lemelson.

In paragraphs 2.g. and 2.h., the Office Action alleges it would have been obvious to modify both Fish's and Lemelson's methods as taught by Goldberg because the ability to receive simultaneous, co-channel responses results in effective and efficient use of the frequency spectrum and reduces the amount of time needed for the master station to receive canned message from all the remote transmitters. However, Goldberg only teaches to alter how systems deal with portable communication unit responses to polls in an ack-back system. Goldberg does not teach modifying triggering events. In particular, triggering events are events that do not originate from the wireless communication system. To the contrary, polls do originate from the wireless communication system. Goldberg only teaches techniques relating to polls, which originate from a portable communication unit wireless communication system. Goldberg does not teach any motivation to modify triggering events.

The motivation of "the ability to receive simultaneous, co-channel responses results [is] effective and efficient use of the frequency spectrum and reduces the amount of time needed for the master station to receive canned message from all the remote transmitters" is not present, expressly or implicdly, in Goldberg or any of the cited references. Furthermore, this motivation was not asserted in the previous Office Action. Applicant asserts that there are no grounds for this motivation in the cited references. If the Office Action is (incorrectly) insinuating this motivation is based on knowledge generally available to one of ordinary skill in the art, Applicant asserts this motivation is a new ground of rejection and the finality of the present Office Action should be withdrawn.

Thus, there is no motivation to combine any of the references to achieve the invention claimed in independent claim 1, and similarly claimed in independent claims 11 and 16. Accordingly, both the double patenting and the obviousness rejections are deficient.

Therefore, Applicants respectfully submit that independent claims 1, 11, and 16 define patentable subject matter. The remaining claims depend from the independent claims and therefore also define patentable subject matter. Accordingly, Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 103.

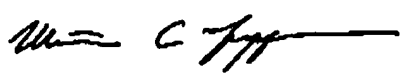
CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

The Commissioner is hereby authorized to deduct any additional fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,



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Dated: September 4, 2003

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